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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,247	05/29/2007	Agostino Vanore	04MAR25553804	6745
27975 7590 08/16/2010 ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST P.A. 1401 CITRUS CENTER 255 SOUTH ORANGE AVENUE P.O. BOX 3791 ORLANDO, FL 32802-3791			EXAMINER KIM, AHSHIK	
			ART UNIT 2876	PAPER NUMBER
			NOTIFICATION DATE 08/16/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

creganoa@addmg.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/590,247	<b>Applicant(s)</b> VANORE, AGOSTINO	
	<b>Examiner</b> Ahshik Kim	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 5/29/07(initial filing of application).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 9-36 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-29 is/are allowed.
- 6) ☒ Claim(s) 30,32 and 33 is/are rejected.
- 7) ☒ Claim(s) 31 and 34-36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/21/06</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. This is the first action relating to U.S. Application Serial No. 10/590,247 filed on May 29, 2007.

#### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Preliminary Amendment***

3. Receipt is acknowledged of the preliminary amendment filed on August 21, 2006. Currently claims 9-36 remain in the examination.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 30, 32, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,402,028 B1 to Graham, Jr. et al. (hereinafter “Graham”).

Re claim 30, Graham discloses a method for manufacturing and personalization of smart cards (see abstract) comprising non-volatile memory such as ROM (col. 1, lines 32-42); storing application and operating system – examples of algorithms - in non-volatile memory (col. 1,

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lines 46+); wherein the non-volatile memory further contains information regarding the state of the application (col. 10, lines 47-61); wherein the identification and application data are checked before the application is loaded and expanded onto the card (see figure 14, and col. 23, lines 60+).

5           Re claims 32 and 33, the personalization is triggered by the script via the terminal (see step 1402 of figure 14), which can be further construed by data sending.

*Allowable Subject Matter*

6.       Claims 9-29 are allowed.

10       7.       Claims 31 and 34-36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8.       The following is a statement of reasons for the indication of allowable subject matter:

The claims are directed at a method for personalizing a smart card by an entity different than a manufacturer. The method comprises performing a security authentication before enabling the

15       algorithm; enabling the algorithm to receive the personalization data and information; storing the information and data in non-volatile memory according to a data structure and an access procedure; and repeating the enabling storing if the personalization data and information were not correct. Such a method for personalizing the smart card, particularly, repeating and enabling

20       step, is neither disclosed nor suggested by the cited references. The method recited in claim 16 and an integrated circuit card recited in claim 23 are also allowable. The subject matter recited in the objected claims are also allowable.

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**Conclusion**

I. The pertinent prior arts made of record but not relied are listed in attached form TO-892. These are considered pertinent to Applicant's disclosure. Applicant is respectfully suggested to carefully review these references.

5 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 8:00 AM to 5:00 PM Monday thru Friday.

10 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax phone number for this Group is (571)273-8300.

15 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

20 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

25 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available for Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions or access to the Private PAIR  
30 system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Ahshik Kim/

35  
Primary Examiner  
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August 11, 2010